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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91224325
Party	Defendant Invicta S.p.A.
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Date	11/19/2015
Attachments	Answer.pdf(25506 bytes )

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the matter of U.S. Trademark Application Serial No. 86/301,552  
For the mark INVICTA  
Published in the *Official Gazette* on June 16, 2015

INVICTA WATCH COMPANY OF AMERICA, INC.

Opposer,

vs.

INVICTA S.P.A.

Applicant.

Opposition No. 91224325

**ANSWER TO NOTICE OF OPPOSITION AND AFFIRMATIVE DEFENSES**

Applicant Invicta S.p.A. (“Applicant”) for its Answer to the Notice of Opposition filed in this proceeding, by its attorneys, states as follows:

1. Applicant lacks knowledge or information sufficient to form a belief as to the truth of the allegations of paragraph 1 of the Notice of Opposition and therefore denies those allegations.

2. Applicant lacks knowledge or information sufficient to form a belief as to the truth of the allegations of paragraph 2 of the Notice of Opposition and therefore denies those allegations.

3. Applicant lacks knowledge or information sufficient to form a belief as to the truth of the allegations of paragraph 3 of the Notice of Opposition and therefore denies those allegations.

4. Applicant lacks knowledge or information sufficient to form a belief as to the truth of the allegations of paragraph 4 of the Notice of Opposition and therefore denies those

allegations, and refers to the records of the U.S. Patent and Trademark Office (“USPTO”) for the particulars of the registrations referred to this paragraph.

5. Applicant lacks knowledge or information sufficient to form a belief as to the truth of the allegations of paragraph 5 of the Notice of Opposition and therefore denies those allegations, and refers to the records of the USPTO for the particulars of the registrations referred to this paragraph.

6. Applicant lacks knowledge or information sufficient to form a belief as to the truth of the allegations of paragraph 6 of the Notice of Opposition and therefore denies those allegations.

7. Applicant lacks knowledge or information sufficient to form a belief as to the truth of the allegations of paragraph 7 of the Notice of Opposition and therefore denies those allegations.

8. Applicant admits that Applicant is an Italian company and refers to the records of the USPTO for the particulars of the registration referred to in paragraph 8 of the Notice of Opposition.

9. Applicant admits that Applicant has not yet used the mark INVICTA for all goods in Class 18 in commerce controlled by Congress as its application in issue, Serial No. 86/301,552, does not seek to cover all goods in Class 18.

10. Applicant admits that Applicant has not yet used the mark INVICTA for all goods in Class 25 in commerce controlled by Congress as its application in issue, Serial No. 86/301,552, does not seek to cover all goods in Class 25.

11. Applicant denies the allegations set forth in paragraph 11 of the Notice of Opposition.

12. Applicant makes no answer to the allegations set forth in paragraph 12 of the Notice of Opposition to the extent those allegations state legal conclusions rather than facts. Applicant further denies knowledge or information sufficient to form a belief as to the truth of the allegations of paragraph 12 of the Notice of Opposition and therefore denies those allegations.

13. Applicant makes no answer to the allegations set forth in paragraph 13 of the Notice of Opposition to the extent those allegations state legal conclusions rather than facts. Applicant further denies knowledge or information sufficient to form a belief as to the truth of the allegations of paragraph 13 of the Notice of Opposition and therefore denies those allegations.

14. Applicant makes no answer to the allegations set forth in paragraph 14 of the Notice of Opposition to the extent those allegations state legal conclusions rather than facts and otherwise denies the allegations of paragraph 14 of the Notice of Opposition.

15. Applicant denies the allegations set forth in paragraph 15 of the Notice of Opposition.

16. Applicant denies the allegations set forth in paragraph 16 of the Notice of Opposition.

### **AFFIRMATIVE DEFENSES**

#### **FIRST AFFIRMATIVE DEFENSE**

1. Applicant and Opposer, Invicta Watch Company of America, Inc. (“Opposer”), have been involved in prior civil litigations and proceedings before the Trademark Trial and Appeal Board.

2. Applicant and Opposer have resolved such prior actions through a series of settlement agreements and a consent agreement (the “Agreements”).

3. Under the terms of the Agreements, Opposer agreed to abstain from using its INVICTA mark in connection with any goods in Classes 18 and 25.

4. Further, pursuant to the Agreements, each party agreed not to oppose, cancel, or otherwise interfere with the use and registration of the other party’s marks.

5. Accordingly, Applicant states that each of the purported claims set forth in the Notice of Opposition is barred in whole or in part by the doctrine of contractual estoppel.

#### **SECOND AFFIRMATIVE DEFENSE**

6. Applicant further states that each of the purported claims set forth in the Notice of Opposition is barred in whole or in part by the *Morehouse* Doctrine.

#### **THIRD AFFIRMATIVE DEFENSE**

7. Applicant further states that each of the purported claims set forth in the Notice of Opposition is barred in whole or in part by the doctrine of unclean hands.

#### **FOURTH AFFIRMATIVE DEFENSE**

8. Applicant further states that each of the purported claims set forth in the Notice of Opposition is barred in whole or in part by the doctrine of laches.

#### **FIFTH AFFIRMATIVE DEFENSE**

9. Applicant further states that each of the purported claims set forth in the Notice of Opposition is barred in whole or in part by the doctrines of waiver and acquiescence.

#### **SIXTH AFFIRMATIVE DEFENSE**

10. Applicant further states that each of the purported claims set forth in the Notice of Opposition is barred in whole or in part by the doctrine of equitable estoppel.

Wherefore, Applicant requests that the Opposition be denied, and that the application proceed to registration.

Dated: New York, New York  
November 19, 2015

Respectfully submitted,

A handwritten signature in blue ink, reading "Jeanne Hamburg".

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the matter of U.S. Trademark Application Serial No. 86301552  
For the mark INVICTA  
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INVICTA WATCH COMPANY OF AMERICA, INC.

Opposer,

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INVICTA S.P.A.

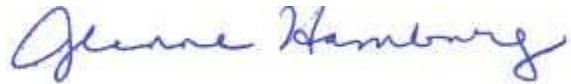
Applicant.

Opposition No. 91224325

**CERTIFICATE OF SERVICE**

I hereby certify that on November 19, 2015, a copy of the foregoing Answer to Notice of Opposition is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed as follows:

Howard Natter  
Natter & Natter  
501 5th Avenue, Suite 808  
New York, New York 10017



Jeanne Hamburg